

REMARKS

This is a full and timely response to the non-final Official Action mailed **November 19, 2003** (Paper No. 7). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, various claims have been amended. Additionally, original claims 16, 19, 26 and 31-33 have been cancelled, and new claims 34-43 have been added. Thus, claims 1-15, 17, 18, 20-25, 27-30 and 34-43 are currently pending for the Examiner's consideration.

In the outstanding Office Action, claims 1-3, 5-6 and 25-27 were rejected as being anticipated under 35 U.S.C. § 102(b) by the Handbook for Palm VII Organizer ("Palm Handbook"). For at least the following reasons, this rejection is respectfully traversed following entry of the present amendment.

Claim 1 now recites:

A portable computing device, comprising:
a user interface having a touch-sensitive display that detects contact between an input device and the display;
a processor; and
a memory that stores a location indicated by a user on the display;
wherein said location is determined by detecting contact between the input device and the display, any movement of the input device across and in contact with the display and removal of the input device from the display; said location being where the input device is removed from the display and not where the input device initially contacts the display.
(emphasis added).

Similarly, claim 25 recites:

A method for entering data on a portable computing device having a memory, a processor, and a touch-sensitive screen, the method comprising:
detecting initial contact between an input device and the screen;

detecting any movement of the input device across and in contact with the screen;
detecting removal of the input device from the screen; and
saving a location corresponding to where the input device is removed from the screen and not where the input device initially contacts the screen.
(emphasis added).

In contrast, the Palm Handbook teaches a portable computing device in which both the location at which the input device initially contacts the screen and the location at which the input device is removed from the screen are taken and stored as user input. None of the cited prior art teaches or suggests the subject matter recited in claims 1 and 25.

Specifically, the Palm Handbook does not teach or suggest storing or saving a location where "said location [is] where the input device is removed from the display and not where the input device initially contacts the display" as recited in claim 1. The Palm Handbook further fails to teach or suggest "saving a location corresponding to where the input device is removed from the screen and not where the input device initially contacts the screen" as recited in claim 25.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, the rejection of claims 1-12, 25 and 27-33 should be reconsidered and withdrawn.

Dependent claims 21-24 also recite subject matter similar to that in claims 1 and 25. Consequently, the rejection of claims 21-24 should also be reconsidered and withdrawn for at least the reasons given above with respect to claims 1 and 25.

Claim 3 recites that “the user interface further comprises a rocker arm.” In contrast, none of the prior art references cited appear to teach or suggest a user interface for a portable computing device that comprises a rocker arm. The recent Office Action does not indicate how or where the cited prior art teaches such subject matter.

Claim 4 further recites that “the rocker arm is movable in both a rotary direction and in a linear direction.” (See Applicant’s Specification, para. 32). This additional subject matter is also not taught or suggested by the prior art of record.

Again, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, for these additional reasons, the rejection of claims 3 and 4 should be reconsidered and withdrawn.

Dependent claims 23 and 24 also recite subject matter similar to that in claims 3 and 4. Consequently, the rejection of claims 23 and 24 should also be reconsidered and withdrawn for at least the reasons give above with respect to claims 3 and 4.

Claim 13 was rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of the Palm Handbook and the Remote Engineering Homepage (the “REH”). Claim 13 is amended herein to include subject matter similar to that originally recited in claim 11. Claim 11 was rejected under 35 U.S.C. § 103(a) over the combined teachings of the Palm Handbook, the REH and U.S. Patent No. 5,907,705 to Carter (“Carter”). For at least the following reasons, claim 13 is now patentable over the prior art of record.

Claim 13 recites:

A computer aided design (CAD) system, comprising:
a main computer that runs a desktop CAD program;
at least one portable computing device that runs a portable CAD program; and
a communication link between the main computer and the at least one portable computing device, wherein the portable CAD program and the desktop CAD program are complementary to allow data to be exchanged between the main computer and the portable computing device;
wherein the portable CAD program generates a script file comprising any additions or changes made with regard to a CAD file on the portable computing device, wherein the script file is separate from the CAD file.

The Palm Handbook is cited as teaching a portable computing device that can work with a main computer. The REH is cited as teaching a CAD program that runs on a portable computing device.

Carter is cited as teaching that changes to an RTI file are stored in a separate file. According to Carter, a Source Code Control System (SCCS) system “stores original [Request to Integrate] RTI files, but does not store changed RTI files per se. Instead, the system 22a stores changes to an original .html file in the SCCS file 22c as a ‘delta’, which consists of only the changes themselves.” (Col. 8, lines 25-30). The RTI files represent “requests to integrate changes into the software release stream” and “are in World Wide Web (WWW) HyperText Markup Language (HTML) text format.” (Abstract).

Consequently, none of the prior art references cited, including Carter, teaches or suggests a Computer Aided Design (CAD) system in which CAD files (as opposed to requests to integrate changes in a software release stream) are edited on a portable computing device and the additions or changes are stored in a separate script file as recited in claim 13.


For at least these reasons, the rejection of claims 13-15, 17, 18 and 20-24 should be reconsidered and withdrawn.

Claim 18 further recites that “the main computer plays the script file against an original CAD file corresponding to the CAD file on the portable computing device to generate a modified CAD file on the main computer.” In contrast, Carter and the other cited prior art fail to teach or suggest editing a file on a portable computing unit, transferring a script file containing only the changes made during editing to a main computer and there playing the script file against an original file to generate a modified file. For at least this additional reason, the rejection of claim 18 should be reconsidered and withdrawn.

New claims 34-38 are thought to be patentable for at least the same reasons given above with respect to claims 1 and 25. New claims 39-43 are thought to be patentable for at least the same reasons given above with respect to claim 3.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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